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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/554,531	08/08/2000	Nigel R. Beeley	238/087 PCT/	2006

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ARNOLD & PORTER
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WASHINGTON, DC 20004-1206

EXAMINER

DELACROIX MUIRHEI, CYBILLE

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/554,531

Applicant(s)

BEELEY ET AL.

Examiner

Cybille Delacroix-Muirheid

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2002 and 01 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30 and 32 is/are allowed.
- 6) ☒ Claim(s) 1-28, 33, 34, 36, 37, 39, 40 and 42-73 is/are rejected.
- 7) ☒ Claim(s) 29, 31, 35, 38 and 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9.5, 12</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

The following is responsive to Applicant's election received May 28, 2002 and the amendment received Oct. 1, 2002.

Applicant's election of SEQ ID NO: 13 with traverse is acknowledged. The traversal is based on the grounds that although the claims encompass several independent species, these species are all related in that they are all extending agonists. Therefore, a search of the entire application can be made without serious burden to the Examiner. In view of these arguments, the election mailed March 26, 2002 is withdrawn.

Claims 1-73 are currently pending.

Information Disclosure Statement

Applicant's Information Disclosure Statements received May 28, 2002 and Dec. 22, 2001 have been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

Specification

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Additionally, please note that at page 5, line 2, the application serial number is missing.

Claim Objections

1. Claims 1, 29, 33-35, 36-38, 39-41, 42, 67, 70 are objected to because of the following informalities: in **claim 1**, there should be a -- . – at the end of the claim. In **claim 29**, there is a duplicate "Xaa₅". Also, the sequence is not numbered correctly.

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Referring to “Ala-Xaa₁₈-...” portion of the sequence, the amino acid “Ala” occupies position 18, therefore “Xaa₁₈” should read –Xaa₁₉— etc. Finally, in **claim 29**, there should be a -- . – at the end of the claim. In **claims 33-35**, line 2, “the administration of” should be deleted and replaced with the phrase –administering to a patient in need thereof--. In **claims 36-38**, lines 1-2, “the administration of” should be deleted. Then at line 1, after “comprising”, the term –administering—should be added. In **claims 39-41**, line 2, the phrase –to the mammal—should be added after “administering.” Also, in **claim 41**, line 1, “hypoglycemic” should be replaced with –hyperglycemic--. In **claim 42**, page 125, line 2, the “or” after “Leu” should be deleted. **Claim 67** is objected to because it is identical to claim 59. One of these claims should be deleted. In **claim 70**, there should be a period at the end of the claim. Appropriate correction is required.

2. Claim 31 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, claim 31 has not been further treated on the merits.

Claim Rejections—35 USC 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-28, 33, 34, 36, 37, 39, 40, 42-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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4. Claim 17 recites the limitation "wherein Xaa₆ is Ala" in line 1. There is insufficient antecedent basis for this limitation in the claim.
5. Claims 20-23 recite the limitations "wherein Xaa₃₉ is Ser or Tyr"; " wherein Xaa₃₉ is Ser" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 58 recites the limitation " wherein Xaa₆ is Ala " in line 1. There is insufficient antecedent basis for this limitation in the claim.
7. Claims 61-64 recite the limitations " wherein Xaa₃₉ is Ser or Tyr"; " wherein Xaa₃₉ is Ser"" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.
8. Finally, in claims 1 and 42, substituent "Xaa₃₉" is not defined. Since, limitations from the specification cannot be read into the claims, one of ordinary skill in the art would not be reasonably apprised of the scope of the claimed method. The metes and bounds of the patent protection desired are unclear.

Allowable Subject Matter

Claims 1-73 are free from the prior art because the prior art does not teach or fairly suggest Applicant's claimed compounds, compositions and methods of use.

Conclusion

Claims 1-28, 31, 33, 34, 36, 37, 39, 40, 42-73 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is 571-272-0572. The examiner can normally be reached on Mon-Fri from 9:30 to 6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on 571-272-0584. The fax phone number for the organization where this application or proceeding is assigned is 571-273-0572.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

CDM

Feb. 20, 2004


Cybille Delacroix-Muirheid
Patent Examiner Group 1600